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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|--------------------|
| 10/532,574 | 04/25/2005 | Hans-Peter Buchstaller | 978725.2 | 4279 |
| 49442 | 7590 | 03/31/2008 | EXAMINER | |
| BAKER & DANIELS LLP 805 15TH STREET, NW, SUITE 700 WASHINGTON, DC 20005 | | | | MORRIS, PATRICIA L |
| ART UNIT | | PAPER NUMBER | | |
| 1625 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 03/31/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/532,574 | BUCHSTALLER ET AL. | |
| | Examiner | Art Unit | |
| | Patricia L. Morris | 1625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. The variations in R² embrace all heterocyclic chemistry.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, Claims 1-6 and 10 drawn to compounds.

Group II, Claims 11 and 12, drawn to compositions containing an additional active Ingredients.

Group III, Claims 26 and 27, drawn to multiple uses.

Group IV, Claim 30, drawn to multiple processes.

Group V, Claims 31, drawn to compounds.

Group VI, Claim 32, drawn to compounds.

Claims 7-9, 13-25, 28 and 29 are drawn to nonstatutory subject matter since they are drafted in terms of use. Further, claims 28 and 29 are dependent on a non-statutory claim. In the event that applicants amend the claims, they will be grouped accordingly.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I and III are related as products and multiple uses. In the instant case, the products as claimed can be used in materially different processes as evidenced by applicants' own claims and specification.

Group I differs in scope because the processes of Group IV do not produce the compounds in Group I.

Groups I and II ,III are unrelated because the compounds of Group I do not require an additional active ingredient for their uses.

Groups I and V,VI are related as final products and intermediates. The compounds of Groups V and VI have different utilities, *i.e.*, herbicides, fungicides, bactericides, corrosion inhibitors, etc., from those of Group I.

Due to the numerous variables in A, B, D, etc.,and their widely divergent meanings, a precise listing of inventive groups cannot be made. Illustrative of different inventive concepts may be made by reference to the compounds in the Examples of the instant application, as for example:

the compounds of

I. compound no. 1,

II. compound no. 4, etc.,

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed do not even belong to a recognized class of compounds and clearly fail to any define a contribution over the prior art. The substituents on the structure vary extensively and when taken as a whole result

in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

In the event of any election of either Groups I, III, IV, V or VI, applicants are required to elect a single compound.

Claims 1-6 and 10 will be examined to the extent readable on the elected compounds.

In the event of an election of Group III, applicants are requested to elect one method of use, *i.e.*, a specific disease.

In the event of an election of Group IV, applicants are requested to elect a single disclosed process of making.

With the election of a specific exemplified compound, a generic concept, will be identified by the examiner as the inventive group for examination.

Because these inventions lack unity of invention for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter restriction for examination purposes as indicated is proper.

Applicant may file the divisional subject matter noted in divisional applications. If applicant wishes a generic expression of the elected invention the claims here need be amended to reflect that election.

This restriction requirement is being written as previous experience has indicated that with Foreign applicants and the inherent time delays, applicants' representative is better able to make an informed, correct, election of the invention applicants would wish to have prosecuted here if

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applicants are given the opportunity to see the restriction requirement laid out, and given the time to make an informed decision.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patricia L. Morris/
Primary Examiner, Art Unit 1625

plm
March 26, 2008